

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mikko K. Makela
Title: User Input System and Method for
Selecting a File
Appl. No.: 10/767,479
Filing Date: 1/28/2004
Examiner: Samir Termanini
Art Unit: 2178
Confirmation Number: 5071

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the New **Pre-Appeal Brief Conference Pilot Program**, announced July 11, 2005, this Pre-Appeal Brief Request is being filed together with a Notice of Appeal.

REMARKS

In the October 18, 2007, Final Office Action, the Examiner maintained his previous rejections of claims 1-48 under 35 U.S. C. § 102(b) as being anticipated by U.S. Publication No. 2002/0041291 (Vale). Applicant objects to this latest Office Action on multiple grounds.

First, Applicant notes that, at Section No. 5 of the October 18, 2007 Office Action, the Examiner asserted that Applicant's prior amendments to Claims 8 and 12 "have been fully considered but are moot in view of the new grounds of rejection necessitated by Applicant's amendment." However, and as discussed below, the Examiner has made no new rejections in the October 18, 2007 Office Action, instead repeating *verbatim* all of his prior art-related rejections. Therefore, this assertion of new grounds of rejections by the Examiner is factually incorrect, since no new grounds of rejection have been proffered.

In addition, Applicant submits that the finality of the October 18, 2007 Office Action is completely improper because the Examiner has failed to consider or address any of the amendments which were made by Applicant in order to overcome Vale. In Applicant's July 31, 2007 Office Action, Applicant amended each of the independent claims to describe how the determining of whether a file was previously selected from a file list occurs *in response to an accessing of the file list*. However, the Examiner failed to consider this language in any of these rejections. Instead, the Examiner simply copied and pasted his arguments relating to Vale from the previous May 1, 2007 Office Action, without making *any* comments regarding the phrase "in response to an accessing of the file list." The Examiner's failure to consider this language is in clear violation of Section 2106 of the Manual of Patent Examining Procedure (MPEP), which explicitly states that "USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation." and "when evaluating the scope of a claim, every limitation in the claim must be considered." Therefore, because the Examiner never even considered this limitation when making the latest round of rejections, , the finality of the October 18, 2007 Office Action is wholly improper and must be withdrawn.

Still further, in addition to amending the independent claims as described above, Applicant also provided two pages of arguments as to why Vale failed to teach or suggest the feature at issue. However, the Examiner has failed to substantively address any of these arguments. This is in clear contravention of Section 707(f) of the MPEP which states that "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of Applicant's argument and answer the substance of it." (emphasis added). In this instance, the Examiner's "response" to Applicant's arguments were not responsive and took Applicant's prior arguments completely out of context.

As a demonstration of how the Examiner has failed to substantively address Applicant's previous arguments, Applicant refers to Section No. 8 of the Office Action. In this section, the Examiner quoted portions of two paragraphs from Applicant's July 31, 2007 response and then noted that "the features upon which applicant relies...are not recited in the rejected claim(s)." However, the sections quoted by the Examiner refer to the teaching of Vale and not the currently pending claims. In other words, Applicant's arguments were directed to how the teachings of Vale were completely different from what is described in the independent claims as amended. For example, the Examiner asserted that Applicant was not permitted to rely on the use of a

direction key because this feature was not recited in the claims. However, Applicant never asserted that the claims of the present application relied on the use of the direction key. Rather, Applicant was saying that the prior art used such a key as the trigger for the “determining” process, and this use was completely different from what is described in the claims. This point was made clearly by Applicant on page 11 of its previous response, where it noted that “[i]n other words, Vale clearly describes a system where any determining and selection of a “next” item in a list occurs in response to an action other than simply accessing the list.” However, this point was simply ignored by the Examiner. Therefore, the Examiner’s “response” to Applicant’s argument regarding this point and others both mischaracterizes Applicant’s arguments and, at the same time, fails to address these arguments in any substantive form.

Still further, Applicant notes that its July 31, 2007 Amendment and Reply provided additional arguments regarding the rejection of claims 18, 26 and 45, noting that Vale fails to teach or suggest saving a file name identifying a selected file. However, the Examiner has completely ignored Applicant’s arguments, once again repeating verbatim his prior rejections without additional comment. Once again, this action by the Examiner is in violation of the requirements of Section 707(f) of the MPEP.

In light of the Examiner’s failure to address Applicant’s prior arguments referenced above, Applicant is incorporating herein by reference all of its arguments that were previously presented in its July 31, 2007 Amendment and Reply, and Applicant respectfully requests that the Examiner reopen prosecution and consider these arguments at this time. In particular, Applicant requests that the Examiner pay particular attention of the fact that all of the pending claims describe the determining of whether a file has been previously selected from the file list as being in response to and accessing of the file list. Applicant also respectfully requests that the Examiner point with particularity to where such support for such a feature can be found in Vale. If the Examiner cannot point with particularity to such a location, then the rejection of these claims based upon Vale cannot stand.

Lastly, Applicant acknowledges that the Examiner did respond to Applicant’s argument concerning claims 19, 27 and 46 of the pending application. However, the Examiner’s arguments as to these claims are not correct. In response to Applicant’s previous arguments, the Examiner quoted paragraph [0045] of Vale and asserted that “element 7, element 6, element 1” serve to

meet the required limitations of these claims. However, this is not correct on multiple grounds. First, Applicant notes that each of the claims at issue explicitly describe the index number as constituting saved information. However, neither this section nor any other portion of Vale teaches an index number as ever being saved in any context.¹ Instead, paragraph [0045] only mentions that the elements cited by the Examiner can be *selected*, which one skilled in the art would recognize is not the same as being saved. Second, Applicant disputes the notion that the elements cited by the Examiner constitute index numbers. Instead, these names are nothing more than designations that are used to select the file at issue, and it is the elements, not index numbers for the elements, which are selected. In fact, the text cited by the Examiner explicitly makes this point, as it notes that “[l]eft and right direction input will select interactive elements in numerical order.” (emphasis added). This is conclusive evidence that Vale is teaching that it is an actual element that is being selected, and not an index number of anything.

For all of the above reasons, Applicant submits that the Examiner’s final rejection of claims 1-48 is wholly improper, since the Examiner failed to consider all of the limitations of the independent claims and failed to substantively address most of Applicant’s arguments. Furthermore, Applicant continues to submit that each of claims 1-48 as amended are separately patentable over Vale for at least the reasons discussed herein and in Applicant’s July 31, 2007 Office Action.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. In view of the foregoing, it is respectfully submitted that the application is in condition for allowance.

Respectfully submitted,

Date: March 18, 2008

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¹ In fact, Applicant notes that the terms “save” or “saved” never appear anywhere in Vale.

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 037145-1101	
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	First Named Inventor Mikko K. Makela		
	Art Unit 2178	Examiner Samir Termanini	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>37,268</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p> </div> <div style="width: 45%; text-align: center;"> <p><u>/G. Peter Albert, Jr./</u> Signature</p> <p><u>G. Peter Albert Jr.</u> Typed or Printed Name</p> <p><u>(858) 847-6735</u> Telephone Number</p> <p><u>March 18, 2008</u> Date</p> </div> </div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input checked="" type="checkbox"/> *Total of 1 forms are submitted.</p>			

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